

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Goldberg	
Application No.: 10/066,243	Art Unit: 2155
Filed: 2/1/2002	
Title: METHOD AND SYSTEM FOR MODIFYING THE CONTENT OF E-MAIL TRANSMISSIONS BASED ON CUSTOMIZATION SETTINGS	Examiner: DUONG, OAHN L.
Attorney Docket No.: 3715P2308CIP2	

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**CORRECTED APPEAL BRIEF UNDER 37 C.F.R. 41.37**

Dear Sir:

This Corrected Appeal Brief is submitted in support of the Appeal in the above-identified application, and is provided in response to the Notification of Non-compliant Appeal Brief mailed on July 26, 2006.

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### **REAL PARTY IN INTEREST**

The real party in interest is Bernel Goldberg.

### **RELATED APPEALS AND INTERFERENCES**

No related appeal is presently pending.

### **STATUS OF CLAIMS**

Claims 1-5, 8-14, 17-23, 26 and 27 stand finally rejected by the Examiner as noted in the Final Office Action dated December 15, 2005. Appellants appeal from all of the rejections of Claims 1-5, 8-14, 17-23, 26 and 27. Claims 6, 7, 15, 16, 24 and 25 are only objected to in the Final Office Action as being dependent on rejected Claims, and are not the subject of this Appeal.

### **STATUS OF AMENDMENTS**

An amendment was filed concurrently with the Appeal Brief filed on May 1, 2006 to rewrite objected-to dependent claims 6, 7, 15, 16, 24 and 25 in independent form as permitted under 37 CFR 41.33 (a)(2). Notice of Entry of the Amendment has not been received by Applicant.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

The invention as recited in independent Claims 1, 10 and 19 encompasses a method (Claim 1), system (Claim 10) and computer program product (Claim 19) for prompting a user for automatic modification of the text of an e-mail message to notify a recipient of a customization setting of the e-mail message.

Claim 1 is representative of independent Claims 10 and 19, as well, and recites:

“receiving a user input indicating that an e-mail message is complete;  
checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting; and  
in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.”

An e-mail program (computer program product) is executed by processor 16 of Figure 1 in a system as described in the specification at pg. 6, line 3 through pg. 7, line 5, and having a method of operation as illustrated in Figure 3 and as described at page 12, line 1, et seq. The e-mail program presents a user interface as depicted in Figure 2 and as described in particular in the specification at pg. 11, lines 1-22.

The program receives a user input indicating completion of the e-mail message (Figure 3, step 50 and associated description in the specification at page 12, lines 2-4) and checks the customization settings of the e-mail message (Figure 3, step 51

and the associated description in the Specification at page 12, lines 4-6). If a customization is detected (Figure 3, step 52 and the associated description in the specification at page 12, lines 6-9), text is generated describing the customization (Figure 3 step 53 and the associated description in the specification at pg. 12, lines 8-9) and the user is prompted with the option to insert the text into the e-mail message (Figure 3, step 54 and the associated description at pg. 12, lines 9-11).

The rejection of Claims 2, 11 and 20 is separately appealed. Claim 2 is representative of Claims 2, 11 and 20 and further recites:

“parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting; and in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting.”

The method (Claim 2), system (Claim 11), and computer-program product (Claim 20) of the above-listed dependent Claims determine if text is already present in the message to indicate the customization (Specification at page 12, lines 6-7), then the prompting as cited and described above is skipped (Specification at page lines 13-18).

The rejection of Claims 8, 17 and 26 is separately appealed. Claim 8 is representative of Claims 8, 17 and 26 and recites:

“wherein said particular customization setting is a copy recipient list, and wherein said modifying modifies said text to include a ‘cc:’ list.” [quotes changed to single quotes for clarity]

The method (Claim 8), system (Claim 17) and computer-program product (Claim 26) of the above-listed dependent Claims add a "cc: list" to the text of an e-mail when e-mail customization includes copied recipients. See prompt 42 in Figure 2, specification at pg. 11, lines 16-20.

None of the Claims include means-plus-function or step-plus-function limitations under 35 U.S.C. §112, ¶6.

#### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. The Examiner has finally rejected Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 as unpatentable under 35 U.S.C.103(a) over Walsh (U.S. 2002/0107924 A1) in view of Tsai (U.S. 6,839,741 B1).
2. The Examiner has finally rejected Claims 3-5, 12-14 and 21-23 as unpatentable under 35 U.S.C. 103(a) over Walsh in view of Tsai, and further in view of Chrabaszcz (U.S. 6,073,133).
3. The Examiner has finally rejected claims 9, 18, and 27 as unpatentable under 35 U.S.C.103(a) over Walsh in view of Tsai, and further in view of Okumura et al. (Okamura)(US 2002/0049793A1).

## ARGUMENT

1. The Examiners rejection of Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 are unpatentable under 35 U.S.C.103(a) over Walsh (U.S. 2002/0107924 A1) in view of Tsai (U.S. 6,839,741 B1) is not well-founded and should be reversed.

Independent claims 1, 10 and 19 recite in part:

“checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting; and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-email message.”

The Examiner has flatly conceded that “Walsh does not explicitly teach modify the text of the email message to notify a recipient of a detected customization setting.” (Final Rejection dated 12/15/05.). None of the references combined with Walsh, including Tsai, supply this deficiency. Yet, the Examiner nevertheless maintains that the claimed invention is obvious, for purposes of the obviousness rejection under 35 USC 103. Applicant respectfully submits that the Examiner’s rejection is fundamentally flawed and must be overturned.

Walsh is directed to attaching actual documents (secondary documents) to an e-mail (primary document) if the e-mail text already includes “indicators” or references to “attachments”, “enclosures” or the like. Similarly, Walsh is also directed to creating a list of “CC” recipients if the e-mail text already includes “indicators” such as the term “CC” or phrase “I have

CC'd". This is to be contrasted with Applicant's claimed invention, in which, for example, actual documents have already been attached or CC recipients already listed in the CC line, but the text of the e-mail message does not include reference to such attached documents or that there are CC recipients. In this example, the user of Applicant's invention may be prompted to add the terms "attachments" and "cc" or the like to the text of the e-mail message before sending, checking, or upon saving of the e-mail message. There is absolutely no description or suggestion in Walsh to modify the text of the e-mail message, notwithstanding the Examiner's rejection and as conceded by the Examiner.

The Examiner further states that modifying the text of an e-mail message to notify a recipient of a detected customization setting is known from Tsai (U.S. 6,839,741) and that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walsh to insert text to notify a recipient of a detected customization as in Tsai "to allow recipient to easily recognize the existence of the attachment file/customization setting by only reading the text of the email message..." However, Tsai is concerned with a different e-mail processing methodology altogether, which consists of stripping attachments from e-mail and inserting text notifying the recipient that the attachment has been stripped. In the terminology used to describe the present invention, Tsai discloses removing a customization and indicating to the e-mail



recipient that the e-mail message has been automatically modified to remove the customization. Moreover, Tsai is directed to an attachment server 90 adding text after the e-mail message has already left the user (Tsai, Column 6, lines 60-66) unlike Applicant's claimed method and system which prompts the user to modify the text before the message is actually sent. Therefore, the proposed combination of Walsh and Tsai does not result in Applicant's invention.

Modifying Walsh with Tsai would also defeat the purpose of Walsh. More specifically, in Walsh, the reference to attachments is already in the text (e.g. by indicators such as "attachments" or "enclosures" or the like) as a reminder that documents should be attached. The text supplied by Tsai in the combination proposed by the Examiner would redundantly provide a second reference to attachments, but that said attachments had been stripped or removed (rather than attached as in Walsh). Therefore, the proposed combination of Walsh with Tsai is inappropriate. Nothing in Walsh in combination with Tsai suggests the methodology and system of the claimed invention, which is to offer the user modification of the text of the e-mail message to notify a recipient of a detected customization setting.

Based on the foregoing, Applicant respectfully submits that independent Claims 1, 10, and 19 are patentable over the cited combination. Because independent Claims 1, 10, and 19 are believed to be patentable, claims 2, 8, 11, 17, 20 and 26

dependent thereon are also believed to be patentable and any rejection thereof has been obviated by the remarks above with respect to the independent claims.

1A. Claims 2, 11 and 20

With respect to dependent claims 2, 11, and 20, the Examiner indicates that Walsh teaches parsing said message to determine whether or not said user has already entered text that will notify a recipient of a particular customization setting, citing to p. 2, ¶23, and in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting (i.e. if the result of the determination is negative, then only primary document is processed, citing to p. 2, ¶ 21). Applicant disagrees.

Walsh, p. 2, ¶21, in describing FIG. 2 there:

“In a first step 100, processor 10 receives primary document 50 from first storage device 20. In a second step 110, processor 110 determines whether any of the plurality of words in the primary document 50 in an indicator ...If the result of the determination at step 110 is positive, then at step 130, processor 10 may then receive a user input indicating the filename and/or the location of secondary document 60. In step 140, processor 10 then attaches secondary document 60 to primary document 50 for further processing at step 150. If the result of the determination at step 110 is negative, then only primary document 50 is processed further at step 120.”

In Applicant's invention as recited in Claims 2, 11, and 20, if the e-mail text already notifies a recipient of a

particular customization setting, the prompt is skipped. By contrast, in Walsh, if the email text includes the indicator (i.e. is positive), the prompt to attach a secondary document is given (not skipped). This rejection underscores the Examiner's fundamental misunderstanding of Walsh as discussed above in the preceding section.

1B. Claims 8, 17 and 26

With respect to dependent claims 8, 17, and 26, the Examiner indicates that Walsh teaches the modification of text to include a cc list, citing to p. 4, ¶¶ 36-38. To the contrary, Walsh refers simply to creating a CC list or adding additional people to an existing CC list and not modifying the text of the e-mail message. Indeed, Walsh states: "A common problem in the e-mail context is that a user may indicate in primary document that a copy will be sent to another person, but forgets to create the CC list or forgets to include a specific secondary recipient." Para. 37. In Applicant's e-mail message, there is no indication in the text of the email message that a copy will be sent to another person until a user automatically modifies the text of said e-mail message "in response to said checking detecting a particular customization setting." Based on the foregoing, the rejection of Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 on the basis of the Walsh and Tsai combination was in error.

2. The Examiner's rejection of Claims 3-5, 12-14 and 21-23 as unpatentable under 35 U.S.C. 103(a) over Walsh in view of Tsai, and further in view of Chrabaszcz (U.S. 6,073,133) is not well-founded and should be reversed.

The Examiner has rejected dependent Claims 3-5, 12-14, and 21-23 under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of Tsai, and further in view of Chrabaszcz (U.S. 6,073,133). The Examiner acknowledges that neither the Walsh nor the Tsai reference explicitly teach user input as claimed, but that "Chrabaszcz teaches the user input instructing an e-mail program to send the e-mail message" (Office Action, page 3, para. 3).

Applicant respectfully submits that this rejection was also in error. Applicant hereby incorporates by reference his discussion above regarding the combination of Walsh and Tsai. Chrabaszcz does not supply the deficiency of Walsh-Tsai, namely the modification of the e-mail text. Chrabaszcz is concerned with determining when a user may intend to attach an attachment based on text included in the message and not *modifying the text of a message to indicate the presence of a customization*.

As independent claims 1, 10, and 19 are believed patentable over the combination of Walsh and Tsai, rejected dependent claims 3-5, 12-14 and 21-23 should similarly be patentable. Accordingly, Applicant respectfully submits that the rejection of claims 3-5, 12-14 and 21-23 was in error.

3. The Examiner's rejection of claims 9, 18, and 27 as unpatentable under 35 U.S.C.103(a) over Walsh in view of Tsai, and further in view of Okumura et al. (Okamura)(US2002/0049793A1) is not well-founded and should be reversed.

Claims 9, 18, and 27 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Tsai, and further in view of Okumura et al (U.S. 2002/0049793). Claims 9, 18 and 27, which are dependent claims, add the feature of modifying the subject line of the e-mail message to indicate a level of urgency after detecting a customization setting of message priority.

Applicant incorporates by reference his discussion above regarding the combination of Walsh and Tsai. The Examiner indicates that Walsh-Tsai does not explicitly teach modifying a subject line of an e-mail message to include an indication of urgency, but that Okumura teaches modifying the subject line of the e-mail message. The Examiner concludes that "[i]t would have been obvious to a person of ordinary skill in the art at the time of [sic] the invention was made to combine the teachings of Walsh-Tsai to include modifying a subject line of the email message because it would enable an improper subject to be eliminated", relying on Okumura, p. 4, ¶88. Again, Walsh-Tsai does not make modifying the text including the subject line obvious and Okumura does not supply the deficiency.

Moreover, the present invention is directed to modifying the subject line of the email message to add, for example, "Urgent" or "Private" or the like upon detection of a customization setting such as respectively, a priority or message type customization setting which is patentably different from "enable[ing] an improper subject to be eliminated."

### **CONCLUSION**

For the reasons stated above, Applicant respectfully submits that the final rejection of Claims 1-5, 8-14, 17-23, 26 and 27 was in error, and that these claims should be allowed. Accordingly, Applicant respectfully urges the Board to reverse the Examiner's final rejection of these claims.

The Fee for Filing both the Notice of Appeal and the Appeal Brief have been paid. No additional fee or extension of time is believed to be required. However, in the event an additional fee or extension of time is required, please charge that fee or extension of time requested to Deposit Account 50-3808.

Respectfully Submitted,

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## **CLAIMS APPENDIX**

1. A method for completing an e-mail transmission, comprising:  
receiving a user input indicating that an e-mail message is complete;

checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting; and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.

2. The method of Claim 1, further comprising:

parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting; and

in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting.

3. The method of Claim 1, wherein said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to send said e-mail message.



4. The method of Claim 1, wherein said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to save said e-mail message.

5. The method of Claim 1, wherein said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to check said e-mail message.

8. The method of Claim 1, wherein said particular customization setting is a copy recipient list, and wherein said modifying modifies said text to include a "cc:" list.

9. The method of Claim 1, wherein said particular customization indicates a level of urgency of said e-mail message and wherein said modifying modifies a subject line of said message to include an indication of said level of urgency.

10. A system for completing an e-mail transmission, comprising:  
a memory for storing program instructions and data;  
a processor coupled to said memory for executing said program instructions; and  
a user input device coupled to said processor for receiving user input, wherein said program instructions include instructions for

receiving a user input indicating that an e-mail message has been completed,

checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting, and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.

11. The system of Claim 10, wherein said program instructions further comprise program instructions for:

parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting; and

in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting.

12. The system of Claim 10, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to send said e-mail message.

13. The system of Claim 10, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to save said e-mail message.

14. The system of Claim 10, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to check said e-mail message.

17. The system of Claim 10, wherein said particular customization setting is a copy recipient list, and wherein said program instructions for modifying modify said text to include a "cc:" list.

18. The system of Claim 10, wherein said particular customization indicates a level of urgency of said e-mail message and wherein said program instructions for modifying modify a subject line of said message to include an indication of said level of urgency.

19. A computer program product comprising signal-bearing media containing program instructions for execution within a general purpose computer, wherein said program instructions comprise program instructions for:

receiving a user input indicating that an e-mail message has been completed,

checking customization settings to determine whether or not to offer modification of the text of the e-mail message to notify a recipient of a detected customization setting, and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the text of said e-mail message.

20. The computer program product of Claim 19, wherein said program instructions further comprise program instructions for:

parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting; and

in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting.

21. The computer program product of Claim 19, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to send said e-mail message.

22. The computer program product of Claim 19, wherein said user input indicating that said e-mail message has been completed is a user input instructing an e-mail program to save said e-mail message.

23. The computer program product of Claim 19, wherein said user input indicating that said e-mail message has been completed is a

user input instructing an e-mail program to check said e-mail message.

26. The computer program product of Claim 19, wherein said particular customization setting is a copy recipient list, and wherein said program instructions for modifying modify said text to include a "cc:" list.

27. The computer program product of Claim 19, wherein said particular customization indicates a level of urgency of said e-mail message and wherein said program instructions for modifying modify a subject line of said message to include an indication of said level of urgency.

**RELATED APPEALS AND INTERFERENCES APPENDIX**

none

**EVIDENCE APPENDIX**

none